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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,099	12/08/2003	Kia Silverbrook	BAL71US	8770

24011 7590 11/03/2004

SILVERBROOK RESEARCH PTY LTD  
393 DARLING STREET  
BALMAIN, 2041  
AUSTRALIA

EXAMINER
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WHIPKEY, JASON T

ART UNIT	PAPER NUMBER
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2612

DATE MAILED: 11/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/729,099	<b>Applicant(s)</b> SILVERBROOK ET AL.	
	<b>Examiner</b> Jason T. Whipkey	<b>Art Unit</b> 2612	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-34 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5,7,9-13 and 32-34 is/are rejected.
- 7) ☒ Claim(s) 6,8 and 14-31 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. ____.  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>12/8/03</u> .   | 6) <input type="checkbox"/> Other: ____.                                    |

## DETAILED ACTION

### *Claim Objections*

1. Claims 22, 30, and 31 are objected to as failing to comply with 37 CFR 1.75(a) for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Claims 22, 30, and 31 each recite the limitation "the camera authentication chip" on lines 6, 1, and 1, respectively. There is insufficient antecedent basis for this limitation in the claim. For examination purposes, the claims will be treated as if they read, "a camera authentication chip".

### *Double Patenting*

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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3. Claims 1-4, 9-13, and 32-34 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2, 4, 10-13, 24, and 26 of copending Application No. 10/729,097. Although the conflicting claims are not identical, they are not patentably distinct from each other because each is a broader recitation of the invention claimed in the '097 application. Therefore, it is encompassed by it. A terminal disclaimer is necessary so as to ensure that any two resulting patents are commonly owned throughout their lifetimes.

Regarding **claim 1** in the instant application, the '097 application claims:

A handheld camera, said camera comprising: a sensor adapted to sense an image (claim 1, lines 1-2); a printer for printing images on media dispensed from a print roll (claim 1, lines 6-7), the print roll comprising a chip having predetermined information stored thereon (claim 2, lines 1-2); a processing system, the processing system being adapted to: obtain the image from the sensor (claim 1, lines 8-9); cause the image to be printed on the media in accordance with the predetermined information (claim 2, lines 2-4).

Regarding **claim 2** in the instant application, the '097 application claims:

A handheld camera as claimed in claim 1, the predetermined information comprising at least one of: Factory Code; Batch Number; Serial Number; Manufacturing date; Media length; Media Type; Pre-printed Media Length; Ink Viscosity; Recommended Drop Volume; Ink Color; and, Remaining Media Length Indicator (claim 4, lines 1-13).

Regarding **claim 3** in the instant application, the '097 application claims:

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A handheld camera as claimed in claim 1, the processing system being adapted to control the printing in accordance with the predetermined information (claim 2, lines 2-4).

Regarding **claim 4** in the instant application, the '097 application claims:

A handheld camera as claimed in claim 1, the processing system being adapted to: manipulate the image in accordance with the predetermined information; and, cause the manipulated image to be printed on the media (claim 1, lines 10-12).

Regarding **claim 9** in the instant application, the '097 application claims:

A handheld camera as claimed in claim 1, the camera comprising a housing adapted to receiving the print roll (claim 1, line 3).

Regarding **claim 10** in the instant application, the '097 application claims:

A handheld camera as claimed in claim 1, the chip being a print roll authentication chip with the predetermined information comprising authentication information, the processing system being adapted to: authenticate the print roll in accordance with the authentication information; and, print the image in accordance with a successful authentication (claim 10, lines 1-6).

Regarding **claim 11** in the instant application, the '097 application claims:

A handheld camera as claimed in claim 10, the authentication being adapted to authenticate the presence of the authentication chip (claim 11, lines 1-2).

Regarding **claim 12** in the instant application, the '097 application claims:

A handheld camera as claimed in claim 10, the authentication being adapted to authenticate the age of the print roll (claim 12, lines 1-2).

Regarding **claim 13** in the instant application, the '097 application claims:

A handheld camera as claimed in claim 12, the camera being adapted to authenticate the age in accordance with the number of times the chip has been authenticated (claim 13, lines 1-3).

Regarding **claim 32** in the instant application, the '097 application claims:

A method of operating a handheld camera, the method comprising: causing a sensor to sense an image; obtaining the image from the sensor (claim 23, lines 1-3); printing the image on media dispensed from a print roll (claim 23, lines 6-9), the print roll comprising a chip having predetermined information stored thereon, the printing being performed in accordance with the predetermined information (claim 24, lines 1-3).

Regarding **claim 33** in the instant application, the '097 application claims:

A method as claimed in claim 32, the method comprising: manipulating the image in accordance with the predetermined information (claim 23, lines 4-5); and, causing the manipulated image to be printed on the media (claim 23, lines 8-9).

Regarding **claim 34** in the instant application, the '097 application claims:

A method as claimed in claim 32, the chip being a print roll authentication chip with the predetermined information comprising authentication information, the method comprising: authenticating the print roll in accordance with the authentication information; and, printing the image in accordance with a successful authentication (claim 26, lines 1-6).

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. Claims 5 and 7 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 2 of copending Application No. 10/729,097 in view of Purcell (U.S. Patent No. 6,227,643).

Regarding **claim 5** in the instant application, the '097 application claims:

A handheld camera, said camera comprising: a sensor adapted to sense an image (claim 1, lines 1-2); a printer for printing images on media dispensed from a print roll (claim 1, lines 6-7), the print roll comprising a chip having predetermined information stored thereon (claim 2, lines 1-2); a processing system, the processing system being adapted to: obtain the image from the sensor (claim 1, lines 8-9); cause the image to be printed on the media in accordance with the predetermined information (claim 2, lines 2-4).

The '097 application does not additionally claim a guillotine activated to cut media from the print roll. However, Purcell discloses a printer, including:

a guillotine (automatic cutting knife 64; see column 4, line 65) the processing system being adapted to activate the guillotine to cut media from the print roll (as shown in Figure 2, processor 52 controls cutting knife 64 via drive circuits 60).

An advantage to including a guillotine to cut media from the print roll is that a more presentable print may be produced for the user, as the user is not required to cut the media



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manually. For this reason, it would have been obvious at the time of invention to have the claimed camera include a guillotine.

Regarding **claim 7** in the instant application, the '097 application claims:

A handheld camera as claimed in claim 5, the camera comprising a print roll drive system for dispensing the media along a print path, the printer being positioned in the print path (claim 1, lines 4-6).

This is a provisional obviousness-type double patenting rejection.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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7. Claims 1-5, 7, 9, 32, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki (U.S. Patent Application Publication No. 2003/0043273) in view of Purcell.

Regarding **claim 1**, Suzuki discloses:

A handheld camera (see Figure 1), said camera comprising: a sensor (CCD 40) adapted to sense an image and a printer (P) for printing images on media (print sheet 11; see paragraph 55) dispensed from a print roll (24; see *id.*).

Suzuki is silent with regard to the print roll including a chip.

Purcell discloses:

a print roll (Figure 8; see column 8, lines 44-45) comprising a chip (memory element 140) having predetermined information stored thereon (see column 9, lines 30-40 and 65-67, and column 10, lines 1-27); a processing system (processor 52), the processing system being adapted to: obtain an image (see column 4, lines 59-61); cause the image to be printed on the media in accordance with the predetermined information (for example, memory element 140 may store the amount of print media remaining on the roll and use that information to determine whether to permit the commencement of a print job; see column 9, lines 47-51, and column 10, lines 22-27).

As stated in column 9, line 65, through column 10, line 8, an advantage to storing data on a chip included on a print roll is that properties of the print roll may be transferred between printing devices along with the roll. For this reason, it would have been obvious at the time of invention to have Suzuki's camera read data from a print roll including a chip.

Regarding **claim 2**, Purcell discloses:

the predetermined information comprising at least one of: Factory Code; Batch Number; Serial Number; Manufacturing date; Media length; Media Type; Pre-printed Media Length; Ink Viscosity; Recommended Drop Volume; Ink Color; and, Remaining Media Length Indicator (memory element 140 may store the amount of print media remaining on the roll and use that information to determine whether to permit the commencement of a print job; see column 9, lines 47-51, and column 10, lines 22-27).

Regarding **claim 3**, Purcell discloses:

the processing system being adapted to control the printing in accordance with the predetermined information (memory element 140 may store the amount of print media remaining on the roll and use that information to determine whether to permit the commencement of a print job; see column 9, lines 47-51, and column 10, lines 22-27).

Regarding **claim 4**, Purcell discloses:

the processing system being adapted to: manipulate the image in accordance with the predetermined information; and, cause the manipulated image to be printed on the media (print data may be modified to correct its color based on the stored paper color; see column 10, lines 9-27).

Regarding **claim 5**, Purcell discloses:

the camera comprising a guillotine (automatic cutting knife 64; see column 4, line 65) the processing system being adapted to activate the guillotine to cut media

from the print roll (as shown in Figure 2, processor 52 controls cutting knife 64 via drive circuits 60).

An advantage to including a guillotine to cut media from the print roll is that a more presentable print may be produced for the user, as the user is not required to cut the media manually. For this reason, it would have been obvious at the time of invention to have Suzuki's camera include a guillotine.

Regarding **claim 7**, Suzuki discloses:

A handheld camera as claimed in claim 5, the camera comprising a print roll drive system (see the various rollers in Figure 1) for dispensing the media (print sheet 11) along a print path, the printer being positioned in the print path (see Figure 1).

Regarding **claim 9**, Suzuki discloses:

A handheld camera as claimed in claim 1, the camera comprising a housing (1a in Figure 2) adapted to receiving the print roll (see Figure 2).

Regarding **claim 32**, Suzuki discloses:

A method of operating a handheld camera (see Figure 1), the method comprising: causing a sensor (CCD 40) to sense an image; obtaining the image from the sensor; printing the image on media (print sheet 11; see paragraph 55) dispensed from a print roll (24; see *id.*)

Suzuki is silent with regard to the print roll including a chip.

Purcell discloses:

a print roll (Figure 8; see column 8, lines 44-45) comprising a chip (memory element 140) having predetermined information stored thereon (see column 9,

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lines 30-40 and 65-67, and column 10, lines 1-27), the printing being performed in accordance with the predetermined information (for example, memory element 140 may store the amount of print media remaining on the roll and use that information to determine whether to permit the commencement of a print job; see column 9, lines 47-51, and column 10, lines 22-27).

As stated in column 9, line 65, through column 10, line 8, an advantage to storing data on a chip included on a print roll is that properties of the print roll may be transferred between printing devices along with the roll. For this reason, it would have been obvious at the time of invention to have Suzuki's camera read data from a print roll including a chip.

Regarding **claim 33**, Purcell discloses:

A method as claimed in claim 32, the method comprising: manipulating the image in accordance with the predetermined information; and, causing the manipulated image to be printed on the media (print data may be modified to correct its color based on the stored paper color; see column 10, lines 9-27).

***Allowable Subject Matter***

8. Claims 6, 8, and 14-31 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Regarding claim 6, no prior art could be located that teaches or fairly suggests a handheld camera with a printer using a paper roll, wherein the paper roll contains a chip storing

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information and a guillotine that is activated in response to a detected attempt to pull the print media from the camera.

Regarding claim 8, no prior art could be located that teaches or fairly suggests a handheld camera with a printer using a paper roll, wherein the paper roll contains a chip storing information and a guillotine that is activated in response to the print media being dispensed at a faster rate than the print roll drive system.

Regarding claim 14, no prior art could be located that teaches or fairly suggests a handheld camera with a printer using a paper roll, wherein the paper roll contains a chip storing information that performs authentication by generating and responding to a challenge.

Regarding claims 15-22, 30, and 31, no prior art could be located that teaches or fairly suggests a handheld camera with a printer using a paper roll, wherein the paper roll contains a chip storing information that performs authentication using first and second encryption keys and transferring a random number encrypted with the second encryption key.

Regarding claims 23-25, no prior art could be located that teaches or fairly suggests a handheld camera with a printer using a paper roll, wherein the paper roll contains a chip storing information that performs authentication using encryption keys and transferring a random number encrypted with one of the encryption keys.

Regarding claims 26-29, no prior art could be located that teaches or fairly suggests a handheld camera with a printer using a paper roll, wherein the paper roll contains a chip storing information that performs authentication using an encryption key and transferring a random number encrypted with the encryption key.

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*Conclusion*

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason T. Whipkey, whose telephone number is (703) 305-1819. The examiner can normally be reached Monday through Friday from 8:30 A.M. to 6:00 P.M. eastern daylight time, alternating Fridays off.

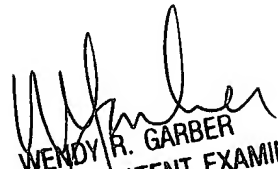
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wendy R. Garber, can be reached on (703) 305-4929. The fax phone number for the organization where this application is assigned is (703) 872-9306.

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JTW

JTW

November 1, 2004

  
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SUPERVISORY PATENT EXAMINER  
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